

**Neifeld Docket No:** PIP-69B-KATZ

Application/Patent No: 09/828,122

USPTO CONFIRMATION NO: 5972

File/Issue Date: 4/9/2001

Inventor/Title: Katz/Paid Promotion Architecture

Examiner/ArtUnit: Rhetta/3622

ENTITY STATUS: Large

**Date Appeal Filed: August 20, 2009**

**Appeal Docket Number: 2010-006083**

**37 CFR 1.7(c) FILING RECEIPT AND TRANSMITTAL LETTER WITH  
AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

1. **THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY FEES  
WHICH MAY BE REQUIRED, OR CREDIT ANY OVERPAYMENT, TO DEPOSIT  
ACCOUNT NUMBER 50-2106.**

2. **FEES PAID HERewith BY EFS CREDIT CARD SUBMISSION: \$ 0**

**A. CLAIMS FEES**

\$ - ( claims previously paid for; currently present; \$52 per addl. claim over 20.)

\$ - ( independent previously paid for; currently present; \$220 per addl. claim over 3)

**B. OTHER FEES**

**FEE FOR NOTICE OF APPEAL AND FEE FOR APPEAL BRIEF, TOTALING \$:**

3. **THE FOLLOWING DOCUMENTS ARE SUBMITTED HERewith:**

37 CFR 41.52 REQUEST FOR REHEARING

4. **FOR INTERNAL NEIFELD IP LAW, PC USE ONLY**

USPTO CHARGES \$: 0 CLIENT BILLING MATTER: BANK ACCOUNT/Check: 6/ G/L ACCOUNT: 5010	FIRM CHARGES \$: DESCRIPTION: FIRM CHARGE FOR . LAWYER:
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INITIALS OF PERSON WHO **ENTERED** ACCOUNTING DATA: RAN

ATTORNEY SIGNATURE (AUTHORIZING DEPOSIT ACCOUNT)

**DATE:** 2-6-2011

**SIGNATURE:** /RichardNeifeld#35,299/

RICHARD NEIFELD REG. NO. 35,299

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## 37 CFR 41.52 REQUEST FOR REHEARING

### I. 37 CFR 41.52 STATES:

Rehearing.

(a)(1) Appellant may file a single request for rehearing within two months of the date of the original decision of the Board. No request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original decision as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section. When a request for rehearing is made, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing.

### II. CLAIM CONSTRUCTION - *"increasing the likelihood ... only if, ... deducting"*

I request rehearing pursuant to 37 CFR 41.52 on the following conclusion as to the meaning of claim 1. You stated that:

We agree with the Examiner that the "if condition" as employed in the method claim 1 is not a limitation against which prior art must be found because the step of deducting from a charge for the purchase transaction a value is conditioned on only if said promotion qualification indicates that both said first product item and said second product item were received via said at least one input device at said POS during said purchase transaction. During examination, claims are given their broadest reasonable interpretation. See *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364

(Fed. Cir. 2004). As under the broadest scenario, the steps dependent on the "if" conditional would not be invoked, the Examiner was not required to find these limitations in the prior art in order to render the claims obvious.

The recitation at issue is the final clause of claim 1, which reads:

" *only if* said *promotion qualification* indicates that both said first product item and said second product item were received via said at least one input device at said POS during said purchase transaction, with said at least one processor, *deducting* from a charge for said purchase transaction a value of promotion associated with said second promotion and a value of promotion associated with said first promotion."

You concluded that the foregoing recitation was no limitation because "*only if*..." was a conditional event that need not occur for the claimed method, that is, that all steps of the claim could be met without "deducting ...". Thus, you read out of the claim a "deducting ..." limitation. You relied upon the appropriate general rule of claim construction, which is the broadest reasonable interpretation consistent with the specification. However, you did not consider the claim language or the specification. To the extent that you think claim construction is a new issue raised on rehearing, note that the claims were subject to several 112 challenges, and the examiner's office actions were less than transparent as to reasoning. It is clear from the record that appellant's arguments assumed that the claims were clear, and that the "only if ... deducting" recitation was a limitations. Accordingly, construction of claim 1 is not a new issue, or if it is, then the you were the first to raise it clearly, and we have should have a right to respond.

The response is, that your claim construction results in an *incomplete* and therefore indefinite claim. This is because the preamble of the claim states:

1. A computer-implemented method *for increasing the likelihood that a first promotion for purchase of an item of a first product or purchase of an item in a first product category will be exercised by a first consumer*, comprising: \*\*\*\*\*

The specification teaches throughout that the goal of the invention is achieved by pairing promotions to increase use of a less relevant promotion. Claim 1 defines the pairing by, and achieves the goal of the preamble only by providing the claimed "discount." Accordingly, the claim is not infringed and does not read on situations where no "discount" issued, because if no discount is issued, then there is no *"increasing the likelihood that a first promotion for purchase of an item of a first product or purchase of an item in a first product category will be exercised by a first consumer."*

Your analysis is similar to the district court's decision commented on in O2 Micro International Limited v. Beyond Innovation Technology Co., Ltd., regarding construing "only if" recitations:

In deciding that " 'only if' needs no construction" because the term has a "well-understood definition," the district court failed to resolve the parties' dispute because the parties disputed not the meaning of the words themselves, but the scope that should be encompassed by this claim language. [O2 Micro International Limited v. Beyond Innovation Technology Co., Ltd., 521 F.3d 1351, \*1361; 2008 U.S. App. LEXIS 7053, \*\*21; 86 U.S.P.Q.2D (BNA) 1304 (Fed. Cir. 2008).]

While "only if", may be clear on its face, that is not the end of the story for claim construction. The words in claim 1 make no sense if claim 1 can be infringed without "discounting" because it is the motivation of "discounting" the cost of the purchase that is what *"increas[es] the likelihood that a first promotion for purchase of an item of a first product or purchase of an item in a first product category will be exercised by a first consumer."* And that is what the specification teaches, as well. See, e.g., the Field of the Invention, specification page 1, referring to "effectively targeting promotions." Thus, while a conditional recitation, in a vacuum, may provide no claim limitation, that is not the situation for claim 1. Claim 1 specifies a preamble which cannot be effective unless a discount is provided. And the specification teaches only targeted marketing, which with respect to incentive offers, means marketing that results in a higher rate of *use of* those offers, and hence discounts. For these reasons, I disagree

with your construction of claim 1. I draw substantially the same conclusion for independent claim 23.

The prior art rejections based upon Deaton, and based upon Aggarwal fail, if you agree that claims 1 and 23 are limited to situations where deductions occur. At least, your decision relies upon your claim construction to affirm all the prior art rejections. Accordingly, if you agree with my arguments for claim construction, then you cannot affirm on the same basis as in your decision on appeal.

### III. 37 CFR 41.50(c)

(c)The opinion of the Board may include an explicit statement of how a claim on appeal may be amended to overcome a specific rejection. When the opinion of the Board includes such a statement, appellant has the right to amend in conformity therewith. An amendment in conformity with such statement will overcome the specific rejection. An examiner may reject a claim so-amended, provided that the rejection constitutes a new ground of rejection.

### IV. REQUEST FOR 37 CFR 41.50(c) EXPLICIT STATEMENT

The determinative issue upon which you affirmed prior art rejections was claim construction clearly different from the applicant's intended claim construction. The purpose of an appeal is finality and repose. However, in this case, your decision does not provide finality because it leaves open whether a claim commensurate in scope with my arguments is non obvious over the Deaton and Aggarwal references. Under your theory of claim construction, however, the issue of whether a claim commensurate in scope with my arguments overcomes the Deaton and Aggarwal rejections, remains indeterminate, requiring further prosecution or appeal. You can resolve that and provide finality and repose by making an explicit statement in the decision on rehearing how claims 1 and 23 can be amended to overcome the Deaton and Aggarwal rejections. For example, you could explicitly state that if the applicant amends claim 1 from:

" ***only if*** said promotion qualification indicates that both said first product item and said

second product item were received via said at least one input device at said POS during said purchase transaction, with said at least one processor, *deducting* from a charge for said purchase transaction a value of promotion associated with said second promotion and a value of promotion associated with said first promotion."

to

" ***when*** said promotion qualification indicates that both said first product item and said second product item were received via said at least one input device at said POS during said purchase transaction, with said at least one processor, *deducting* from a charge for said purchase transaction a value of promotion associated with said second promotion and a value of promotion associated with said first promotion."

For example, you could explicitly state that if the applicant amends claim 23 from:

" said at least one processor, for deducting, ***only if*** said promotion qualification indicates "

to

" said at least one processor, for deducting, ***when*** said promotion qualification indicates "

If you do not on rehearing reverse the prior art rejections, I request that you make an explicit statement as to what claim language amendment will overcome the Deaton and Aggarwal rejections of record.

Respectfully,

Date: 2/6/2011

/RichardNeifeld#35,299/

RICHARD NEIFELD, REG. NO. 35,299

Attorney of Record

Printed: February 7, 2011

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